

### **REMARKS**

This responds to the Office Action mailed on June 8, 2006, and the references cited therewith.

#### **§101 Rejection of the Claims**

Claims 1-58 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The pending claims each comply with multiple rules for construing them as statutory subject matter according to the cited MPEP §2106, as follows.

Claims 1-28 each comprise a semiconductor parametric test system, and any portion of the recited modules such as the control module that may be implemented in software is part of an otherwise statutory item of manufacture or machine. MPEP 2106 IV, B, 1, a, third paragraph, states “Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim”.

MPEP 2106 IV, B, 2, a, further states that “If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product.” Here, the combination of modules such as the control module in a semiconductor test system with operation of semiconductor test equipment and parametric test instrumentation equipment qualify the pending claims as statutory under 35 U.S.C. §101. Further, the same section of the MPEP states that “A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory.” Here, the claims are clearly directed to a machine or system for performing semiconductor testing, and have a practical application in the technological arts and produce a useful and tangible result.

Regarding apparatus claims 1-28 and method claims 29-43, these claims each have a physical component, such that elements of the claims that may be computerized are tied to physical objects or activities outside the computer. For example, Claim 1 recites control of semiconductor test equipment, and operation of parametric test instrumentation. This qualifies the claim as statutory under the safe harbor rules laid forth in MPEP 2106 IV, B, 2, b, i, which state “Another statutory process is one that requires the measurement of physical objects or

activities to be transformed outside of the computer into computer data.”. Here, the control and operation of semiconductor parametric test instrumentation and of semiconductor test equipment is an activity outside the computer, qualifying the pending claims as statutory under 35 U.S.C. § 101.

Claims 44-58 recite an article of manufacture, and are statutory Beauregard claims as such under 35 U.S.C. §101. The Office Action provides no basis for its argument that a machine-readable medium isn’t statutory while a computer readable medium would be, and review of MPEP 2106 suggests repeatedly that embodiment in a physical medium of any type qualifies machine-readable instructions as statutory subject matter under 35 U.S.C. § 101, as the functionally descriptive material is “structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” (*citing* MPEP 2106, IV, B, 1, paragraph 2). Reexamination and allowance of these pending claims is therefore respectfully requested.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9581 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SERGEY A. VELICHKO ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 371-2157

Date

8 September 2006

By

David R. Cochran  
David R. Cochran  
Reg. No. 46,632

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8 day of September 2006.

LISA ROSORSKE

Name

Sean Rosorske

Signature